

REMARKS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

I. Preliminary Amendment to Specification

On the date of filing the present application, February 27, 2006, Applicant submitted concurrently a preliminary amendment to amend a certain section of the Specification. Under 37 C.F.R. § 115 and MPEP § 706.03(o), the preliminary amendment should be deemed as a part of the original disclosure. The Applicants note that the filed amendments are not yet reflected in the application as published (US 2007/0072923). The Applicants respectfully request that the amendments be entered and considered as a part of the original disclosure.

II. Status of the Claims

Claims 1-8 and 11-12 are cancelled. The cancellation of claims does not constitute acquiescence that the rejection was proper, and the Applicants reserve the right to pursue the subject matter in the cancelled claims in a subsequent continuation application. New claims 13-17 are added based on claims 2-6, respectively, and claim 9 as filed. New claims 18 and 19 are added with support from claims 9 and 2, respectively, as filed. No new matter is introduced, and claims 9-10, and 13-19 are pending to be examined on their merits.

III. Claim Rejection – 35 U.S.C. § 112

Claims 1-10 are rejected under 35 U.S.C. § 112, ¶ 2, as allegedly indefinite. In view of the foregoing amendments, the Applicants respectfully submit that the rejection is now moot.

IV. Claim Rejections – 35 U.S.C. § 103

Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Daumas (US 5,371,233). Claims 1-10 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Daumas in view of Buhlmyer (US 5,399,578 or US 5,965,592). The Applicants respectfully traverse the rejections.

While not acquiescing to the grounds of rejections, claims 11 and 12 are cancelled. In view of the cancellation of claims 11 and 12, the rejection related thereto is moot.

Also without acquiescing to the grounds of rejection, claims 2-8 are combined with claim 9 and represented as new claims 13-17, respectively, and new claims 18 and 19 are added as dependent claims of claim 10 with support from claim 9 and previous claim 2, respectively.

(i) Current Obviousness Standard

The Supreme Court recently reaffirmed the Graham factors for determining obviousness in *KSR Int'l Co. v. Teleflex Inc.* (No. 04-1350) (U.S., April 30, 2007). The Graham factors, as outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966), are: 1) determining the scope and contents of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; 3) resolving the level of ordinary skill in the pertinent art; and 4) evaluating evidence of secondary consideration. The Supreme Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a), and held that the proper inquiry for determining obviousness is whether the improvement is more than the predictable use of prior art elements according to their established functions. The Court noted that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed, and specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the

background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was *an apparent reason to combine the known elements in the fashion claimed* by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR Int'l Co. v. Teleflex Inc., slip op. at 14 (emphasis added). As discussed below, the cited art cannot render the claimed invention obvious.

(ii) *No Reason to Combine Daumas with Buhlmayer*

Neither Daumas nor Buhlmayer teaches or suggests the purification process of a crystal with tetrahydrofuran, as recited in the present claims. The only disclosure related to tetrahydrofuran in Daumas is that it is in an anhydrous form, which is in contrast to the tetrahydrofuran as recited in the present claims, which tetrahydrofuran is in a liquid form containing the purified crystals therein. Buhlmayer also does not disclose the use of tetrahydrofuran in the purification process of the crystal as claimed. At least in view of the foregoing reasons, one of ordinary skill in the art would not have been motivated to combine the teachings of Daumas and Buhlmayer to arrive at the current claims. *See KSR Int'l Co.*

Additionally, the Office alleges that because the amide of Buhlmayer and carbaldehyde as recited in the present claims are well known in the art as angiotensin II antagonists, one of ordinary skill in the art would expect them to have the same properties and to have a reason to combine the teachings of Buhlmayer and Daumas to reach the claimed processes. Office Action, p. 7. The Applicants respectfully traverse and submit that the Office's statement was based only on speculation. The "properties" of these compounds, referred to by the Office, relate to the effects of these compounds on the biological systems (or biological activity) – e.g., an angiotensin can cause blood vessels to constrict. However, the processes as recited in the present claims refer to chemical processes in which a purified crystal is formed. The Applicants respectfully submit that what the product can do to a biological system after formation (i.e., constricting blood vessels) should not be confused with the processes and ingredients leading to forming such a product. For example, one of ordinary skill in the art would appreciate that amide

and carbaldehyde are different compounds with distinct chemical properties, particularly in chemical reactions. Thus, one of ordinary skill in the art would not have considered the compounds of Buhlmayer, Daumas, and those instantly claimed to be the same and would not have a reason to combine the teachings of Buhlmayer and Daumas to reach the presently claimed processes.

The Office acknowledges that a prima facie case of obviousness may be rebutted with unexpectedly good results. Office Action, p. 7. The Applicants respectfully submit that the presently claimed processes provide such unexpectedly good results. As provided by the Examples in the Specification as filed, the presently claimed processes provide 2'-(1H-tetrazol-5-yl)biphenyl-4-carbaldehyde in high yield and high purity. The high yield and purity could not have been attained by the processes and compounds as disclosed in Daumas and Buhlmayer. Thus, Daumas and Buhlmayer, alone or in combination, cannot render the present claims obvious.

Therefore, at least in view of the foregoing, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION


The Applicants believe that the present application is now in condition for allowance and respectfully request favorable reconsideration.

The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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